

**THIS OPINION WAS NOT WRITTEN FOR PUBLICATION**

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 20

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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**Ex parte** SHUICHI KIKUCHI

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Appeal No. 96-4193  
Application No. 08/267,049<sup>1</sup>

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HEARD: June 8, 1999

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Before JOHN D. SMITH, WALTZ and SPIEGEL, **Administrative Patent Judges**.

WALTZ, **Administrative Patent Judge**.

**DECISION ON APPEAL**

This is an appeal from the examiner's refusal to allow claims 1 through 4 as amended after the final rejection (see the amendment dated Sept. 7, 1995, Paper No. 8, entered as per the Advisory Action dated Sept. 29, 1995, Paper No. 9).

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<sup>1</sup> Application for patent filed June 28, 1994.

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According to appellant, the invention is directed to a disc cartridge liner for wiping off the dust deposited on a recording disc where the liner includes a thermoplastic fiber entangling body and a cellulose fiber entangling body (Brief, pages 2 and 4). Claim 1 is illustrative of the subject matter on appeal and is reproduced below:

1. A disc cartridge liner comprising: a thermoplastic fiber entangling body composed of entangled thermoplastic fibers, and a cellulose fiber entangling body composed of entangled regenerated cellulose fibers and refined cellulose fibers, the thermoplastic fiber entangling body and the cellulose fiber entangling body being heated and pressed to be attached to each other.

The examiner has relied upon the following references as evidence of obviousness:

Howey	5,060,105	Oct. 22, 1991
Takemae et al. (Takemae)	5,122,919	Jun. 16, 1992
Vogt	2 325 715	Dec. 19, 1974
(Published German Offenlegungsschrift) <sup>2</sup>		

Claims 1 through 3 stand rejected under 35 U.S.C. § 103 as unpatentable over Takemae in view of Vogt (Answer, pages 3-

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<sup>2</sup> The examiner apparently relies upon an English abstract of this reference (see the PTO-892 accompanying the rejection dated Jan. 24, 1995, Paper No. 4, and the Brief dated Apr. 29, 1995, Paper No. 13, page 11). We refer to and cite from an English translation of the entire document provided as Appendix B to appellant's Brief.

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5). Claim 4 stands rejected under 35 U.S.C. § 103 as unpatentable over Takemae in view of Vogt and Howey (Answer, page 5). We reverse both of the examiner's rejections for reasons which follow.

**OPINION**

The disc cartridge liner of appealed claim 1 comprises entangled thermoplastic fibers and entangled regenerated cellulose fibers and refined cellulose fibers. The examiner finds that Takemae discloses a disc cartridge liner comprising a thermoplastic fiber and a regenerated cellulose fiber (Answer, page 3). The examiner recognizes that Takemae does not disclose refined cellulose fibers as required by appealed claim 1 (Answer, page 4). The examiner cites Vogt (M1159V/52) for the disclosure of "a protective sleeve of a video record comprising fibers made by plastics or semi-synthetic material consisting of a modified cellulose (a refined cellulose fiber inherently)." (*Id.*). The examiner concludes that it would have been obvious to make the disc liner of Takemae with both a regenerated cellulose fiber and a refined cellulose fiber "as inherently taught by M1159V/52 [Vogt]." (*Id.*).

The examiner does not provide any factual support for the finding that the "modified cellulose" of Vogt is "inherently" a refined cellulose fiber. See the specification, page 9, where appellant discloses the preparation and characteristics

of "refined cellulose fibers". The term "modified cellulose" is well known in the art<sup>3</sup> and has not been shown by the examiner to necessarily include the "refined cellulose fibers" taught in appellant's specification and recited in appealed claim 1.

Even assuming that "modified cellulose fibers" are the same as "refined cellulose fibers", the examiner has failed to show any reasoning, motivation or suggestion for combining the teachings of Takemae and Vogt in the manner proposed (see the Brief, pages 11-12). The examiner must specifically identify the reasons one of ordinary skill in the art would have been motivated to select the references and combine them. *See In re Dembiczak*, \_\_\_ F.3d \_\_\_, \_\_\_, 50 USPQ2d 1614, 1617-1618 (Fed. Cir. 1999); *In re Rouffet*, 149 F.3d 1350, 1359, 47 USPQ2d 1453, 1459 (Fed. Cir. 1998). The examiner sets forth a sweeping rationale that it would have been obvious to make a disc liner with regenerated and refined cellulose fibers "to avoid scratching disc surface in order to protect disc surface

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<sup>3</sup> See Hawley, *The Condensed Chemical Dictionary*, 10th ed., pp. 210-211, Van Nostrand Reinhold Co., 1981, a copy of which is attached to this decision.

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without damage" (Answer, page 4). However, the examiner does not specifically identify why the artisan would have used the protective "modified cellulose fiber" lining of Vogt *in addition to* the two lining materials of Takemae while keeping both types of cellulose fibers together and entangled.

The examiner additionally applies the Howey reference against claim 4 for the disclosure of using a rubber based binder but this reference does not cure the deficiencies noted above. Howey discloses a web of nonwoven synthetic fibers which are thermally spot welded to form the basic liner fabric (column 3, lines 59-62). Howey exemplifies many types of fibers including cellulosic fibers but does not disclose or teach refined cellulose fibers (see column 4, lines 6-10; lines 31-33; and column 6, lines 9-25).

For the foregoing reasons, we determine that the examiner has not established a *prima facie* case of obviousness in view of the applied prior art. Accordingly, the rejection of claims 1 through 3 under 35 U.S.C. § 103 as unpatentable over Takemae in view of Vogt is reversed. The rejection of claim 4 under § 103

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as unpatentable over Takemae in view of Vogt and Howey is also reversed. *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992).

The decision of the examiner is reversed.

**REVERSED**

JOHN D. SMITH	)	
Administrative Patent Judge	)	
	)	
	)	
	)	
	)	BOARD OF PATENT
THOMAS A. WALTZ	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
CAROL A. SPIEGEL	)	
Administrative Patent Judge	)	

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